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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Michael D. Hooven

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COOK ALEX LTD

SUITE 2850

200 WEST ADAMS STREET

CHICAGO, IL 60606

EXAMINER

CHEN, VICTORIA W

ART UNIT

PAPER NUMBER

3739

MAIL DATE

DELIVERY MODE

02/06/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/015,868	<b>Applicant(s)</b> HOOVEN, MICHAEL D.	
	<b>Examiner</b> VICTORIA W. CHEN	<b>Art Unit</b> 3739	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on 12 November 2008.

2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 76-78 and 80 is/are pending in the application.

    4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 76-78 and 80 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All    b) ☐ Some \*    c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
    Paper No(s)/Mail Date \_\_\_\_\_.

4) ☐ Interview Summary (PTO-413)  
    Paper No(s)/Mail Date \_\_\_\_\_.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 60/200072, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. Specifically 60/200072 fails to disclose at least one internal jaw support member and an insulative cover sufficiently surrounding the internal jaw support member to prevent contact of the internal jaw support member with a selected ablation area, an opening disposed on the jaw assembly or in the insulative cover for receiving the conductive member, and each elongated conductive member protruding through an opening in the respective insulative cover.

***Allowable Subject Matter***

The indicated allowability of claims 77-80 is withdrawn in view of the newly discovered reference(s) to Lingenfelder et al. (US 5668380 B2). Rejections based on the newly cited reference(s) follow.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 76, 77, 78 and 80 are rejected under 35 U.S.C. 102(e) as being anticipated by Lingenfelder et al. (US 6558380 B2).**

Regarding claim 76, Lingenfelder discloses a first and second jaw assemblies [4, 5, Fig. 1] movable between open and closed positions, each jaw assembly [col. 5, ll. 40-42] having an elongated electrically conductive member [6.2, Fig. 3a], the conductive members of the jaw assemblies being in face to face relation [Fig. 3c] and connectible to a bipolar energy power source [col. 4, ll. 44-48], each jaw assembly including one internal jaw support member [10.2, Fig. 3a] and an insulative cover [11.2] that sufficiently surrounds the internal jaw support member to prevent contact of such internal jaw support member with the selected ablation area [Fig. 3a], wherein each jaw assembly has a clamping surface [right half of Fig. 3a] and each

insulative cover is located on each side of the respective elongated conductive member [Fig. 3a] of the corresponding jaw assembly and forms the clamping surface.

Regarding claims 77 and 78, Lingenfelder discloses each jaw assembly includes an opening disposed for receiving the respective conductive member therein [e.g. Fig. 3a, the concavity formed by insulative cover 11.2 in which conductive member 6.2 sits].

Regarding claim 80, Lingenfelder discloses the elongated conductive member [6.2] protrudes through an opening in the respective insulative cover [11.2, Fig. 3a].

### ***Response to Arguments***

Applicant's arguments with respect to claims 76, 77, 78 and 80 have been considered but are moot in view of the new ground(s) of rejection.

Since the internal jaw support member and subsequent details in the dependent claims listed in the above Priority section appear to lack support in the disclosure of the Provisional Application 60/200072 from which the current application claims priority, the new priority date for the current application is considered to be 12/22/00, the filing date of Application 09/747609, in which support for the current claim limitations can be seen in Fig. 32 and disclosed in pgs. 14-15 of the specification.

New reference, Lingenfelder, has been applied in light of the new priority date.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTORIA W. CHEN whose telephone number is (571)272-3356. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Peffley/  
Primary Examiner, Art Unit 3739

/Victoria W Chen/  
Examiner, Art Unit 3739